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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,240	01/23/2004	Mark T. Kirsch	8404.004	4511

7590 02/28/2006

BERENATO, WHITE & STAVISH  
SUITE 240  
6550 ROCK SPRING DRIVE  
BETHESDA, MD 20817

EXAMINER
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PHAM, MINH CHAU THI

ART UNIT	PAPER NUMBER
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1724

DATE MAILED: 02/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/762,240

Applicant(s)

KIRSCH, MARK T.

Examiner

Minh-Chau T. Pham

Art Unit

1724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kometani et al (5,720,790), in view of Peng (6,864,195 B2).

Kometani et al disclose a filter element (100) comprising a filter media (110) having filter face portions and at least one side portion joined thereto by a corner portion, a seal (220) or gasket having a bendable contact portion (see 233 in Fig. 26) and homogeneously formed unitarily with the solid resilient material, and the seal being formed directly integrally on the filter media (see Abstract, Figs. 7-10, 18-20, 23-29, col. 3, line 53 through col. 4, line 13, col. 4, lines 25-38 and lines 46-54, col. 8, lines 1-9). Claims 1-25 differ from the disclosure of Kometani et al in that the seal is formed of thermoplastic material which is a thermoplastic elastomers (TPE). Peng discloses a seal or gasket material being made of TPE or thermoplastic elastomers (col. 3, lines 14-33, col. 4, lines 24-32) made of particles embedded in ethylene-propylene terpolymer, wherein these materials have found utility in many applications which previously used vulcanized rubber, e.g. hose, gaskets, and the like (col. 4, lines 19-32). Peng further discloses TPO is well-known to be useful in producing gaskets or seals through conventional extrusion, calendaring or injection molding processes (see col. 3, lines 14-17). It is inherently understood that TPO is used in the production of filter element with sealing or gasket means via injection molding process. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide

thermoplastic elastomers as taught by Peng as the seal in the filtering apparatus of Kometani et al since it is well-known in the art that TPE produces finished articles having resilient rubber-like properties without the need for vulcanizing cure of the finished articles (col. 3, lines 26-28).

### ***Double Patenting***

Claims 1, 3, 5, 6, 8-10 and 12-18 of this application again conflict with claims 1, 4, 5, 7-9 and 11-16 of Application No. 10/404,109. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

### ***Response to Arguments***

Applicant's arguments filed on December 20, 2005 have been fully considered but they are not persuasive.

Applicant argues that the primary reference Kometani et al does not disclose the seal portion being a solid resilient thermoplastic material. The Examiner still maintain Kometani et al as the primary reference and re-introduces Peng as the secondary reference in combination with Kometani et al under the 103 rejections to show: Kometani et al disclose a filter element (100) comprising a filter media (110) having filter face portions and at least one side portion joined thereto by a corner portion, a seal

(220) or gasket having a bendable contact portion (see 233 in Fig. 26) and homogeneously formed unitarily with the solid resilient material, and the seal being formed directly integrally on the filter media (see Abstract, Figs. 7-10, 18-20, 23-29, col. 3, line 53 through col. 4, line 13, col. 4, lines 25-38 and lines 46-54, col. 8, lines 1-9). Claims 1-25 differ from the disclosure of Kometani et al in that the seal is formed of thermoplastic material. Peng discloses a seal or gasket material being made of TPE or thermoplastic elastomers (col. 3, lines 14-33, col. 4, lines 24-32) made of particles embedded in ethylene-propylene terpolymer, wherein these materials have found utility in many applications which previously used vulcanized rubber, e.g. hose, gaskets, and the like (col. 4, lines 19-32). Peng further discloses TPO is well-known to be useful in producing gaskets or seals through conventional extrusion, calendaring or injection molding processes (see col. 3, lines 14-17). It is inherently understood that TPO is used in the production of filter element with sealing or gasket means via injection molding process. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide thermoplastic elastomers as taught by Peng as the seal in the filtering apparatus of Kometani et al since it is well-known in the art that TPE produces finished articles having resilient rubber-like properties without the need for vulcanizing cure of the finished articles (col. 3, lines 26-28).

In response to applicant's argument that the Peng reference is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the

claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Peng discloses a seal or gasket material being made of TPE or thermoplastic elastomers (col. 3, lines 14-33, col. 4, lines 24-32) made of particles embedded in ethylene-propylene terpolymer, wherein these materials have found utility in many applications which previously used vulcanized rubber, e.g. hose, gaskets, and the like (col. 4, lines 19-32). Peng further discloses TPO is well-known to be useful in producing gaskets or seals through conventional extrusion, calendaring or injection molding processes (see col. 3, lines 14-17). It is inherently understood that TPO is used in the production of filter element with sealing or gasket means via injection molding process.

Regarding to the double patenting issue, there is no difference between a "solid resilient thermoplastic material" and a "cell-less resilient thermoplastic material" since thermoplastic material is very well-known and widely used in sealing or gasket material. Therefore, the double patenting rejection is proper and hereby made final.

Applicant's arguments with respect to claims 1-25 have been thoroughly considered but are moot in view of the new ground(s) of rejection, as discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh-Chau T. Pham whose telephone number is (571) 272-1163. The examiner can normally be reached on Mon/Tues/Thur/Fri 7:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**Minh-Chau Pham**  
**Patent Examiner**  
**Art Unit: 1724**  
**February 23, 2006**